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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,559	12/19/2000	Bridget D. Kimball	18926-003500US	4506
20350	7590	05/24/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			DAVIS, ZACHARY A	
			ART UNIT	PAPER NUMBER
			2137	5

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/740,559

Applicant(s)

KIMBALL ET AL.

Examiner

Zachary A Davis

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2, 4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "720" has been used to designate both "Java Virtual Machine" and "HTML" in Figure 7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 714, 720, 724, 924, 932, and 1034. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 728. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities:

Page 8, lines 33-34 refer to "printer port resource 816". From the figures, it appears that this is intended to read "printer port resource 814".

The specification appears to contain minor typographical errors. For example, on page 3, line 30, it is assumed that "headed" is intended to read "headend", and on page 7, line 26, it is assumed that "anotherobject" is intended to read "another object". Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Appropriate correction is required.

Claim Objections

5. Claims 6 and 19 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Specifically, Claim 6 recites that receiving authorization information comprises receiving an authorization message. Similarly, Claim 19 recites that code for receiving authorization information comprises code for receiving an authorization message. However, "authorization message" does not further limit "authorization information".

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, claims 1, 9, and 14 recite that receipt of a message is blocked based on “determining if the conditional access receiver is authorized”. However, the specification does not describe this; the specification instead describes blocking receipt of a message if the receiver is not authorized to receive that message. Further, claims 2-8, 10-13, and 15-20 are rejected due to their dependence on the rejected base claims.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites that receipt of a message is blocked based on “determining if the conditional access receiver is authorized” in lines 8-9. However, the specification describes blocking receipt of a message if the receiver is not authorized. This contradiction renders the claim indefinite.

Similarly, Claim 9 recites that receipt of a message is blocked based on “determining if the first conditional access receiver is authorized” in lines 10-12, whereas the specification discloses blocking receipt of a message if the receiver is not authorized, which renders the claim indefinite.

Further, Claim 14 recites that receipt of a message is blocked based on “determining if the conditional access receiver is authorized” in lines 9-10. The claim is rendered indefinite by a similar rationale as applied to claims 1 and 9 above.

For purposes of applying the prior art, it is assumed that the claims are intended to refer to blocking a message when the receiver is not authorized, as described in the specification.

Claims 2-8, 10-13, and 15-20 are rejected due to their dependence on the rejected base claims.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-4, 6-11, 13-17, and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Wasilewski, US Patent 5420866.

In reference to Claim 1, Wasilewski discloses a method for distributing a message in a conditional access system including receiving authorization information (column 14, lines 33-37), storing authorization information (column 11, lines 26-29), determining an identifier with the authorization information (column 13, lines 53-60), determining if the receiver is authorized to receive the message (column 14, lines 62-65), and blocking receipt of the message if the receiver is not authorized (column 14, line 68-column 15, line 6, where if a receiver is authorized, the program is output).

In reference to Claim 2, Wasilewski further discloses recognizing that the message corresponds to the identifier (column 13, lines 56-63) and ignoring a portion of a datastream associated with the message (column 13, lines 60-63, where only some of the packets are extracted).

In reference to Claim 3, Wasilewski further discloses that determining the identifier includes retrieving a subtype identifier from a header (column 8, line 68-column 9, line 6, where the header includes packet IDs).

In reference to Claim 4, Wasilewski further discloses that determining if the receiver is authorized includes determining entitlement for the message (column 14, lines 62-65, where the EMM is an Entitlement Management Message).

In reference to Claim 6, Wasilewski further discloses that the method includes receiving an authorization message (column 14, lines 33-37).

In reference to Claim 7, Wasilewski further discloses that the authorization information is stored in solid state memory (column 13, lines 44-45).

In reference to Claim 8, Wasilewski further discloses checking authorization within the receiver (column 14, lines 62-65).

In reference to Claim 9, Wasilewski discloses a method for distributing a message in a conditional access system including receiving authorization information at a first receiver (column 14, lines 33-37), determining if the first receiver is authorized to receive the message (column 14, lines 62-65), receiving authorization information at a second receiver (column 14, lines 33-37), determining if the second receiver is authorized to receive the message (column 14, lines 62-65), blocking receipt of the message in the first receiver if the first receiver is not authorized (column 14, line 68-column 15, line 6, where if a receiver is authorized, the program is output), and receiving the message in the second receiver if the second receiver is authorized (column 14, line 68-column 15, line 6).

In reference to Claim 10, Wasilewski further discloses ignoring a portion of a datastream associated with the message (column 13, lines 60-63, where only some of the packets are extracted).

In reference to Claim 11, Wasilewski further discloses that determining if the first receiver is authorized includes determining entitlement for the message (column 14, lines 62-65, where the EMM is an Entitlement Management Message).

In reference to Claim 13, Wasilewski further discloses checking authorization within the first receiver (column 14, lines 62-65).

Claims 14-17 and 19-20 are directed to a software program product and correspond substantially to method claims 1-4 and 6-7, respectively, and are rejected by a similar rationale.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 5, 12, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski in view of McClellan et al, US Patent 5619250.

In reference to Claims 5 and 12, Wasilewski discloses everything as applied to Claims 1 and 9 above. However, Wasilewski does not specifically disclose that the message includes a software program.

McClellan discloses a system for television system set top boxes which includes receiving a software module sent from a central system in a set top box (column 7, lines 23-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the methods of Wasilewski to include sending software programs in the conditional access system, in order to allow for software modules to be downloaded after the system has been initialized and to be functional upon receipt without the need for restarting the system (see McClellan, column 5, lines 10-14).

Claim 18 is a software program product claim that corresponds substantially to the method of Claim 5, and is rejected by a similar rationale.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


- a. Kahn, US Patent 5978649, discloses a broadcast system including receivers containing authorization information for determining which of received signals the receiver is allowed to process.
- b. Pinder et al, US Patent 6105134, disclose a conditional access system including sending authorization information for purchased services.
- c. Lee et al, US Patent 6266481, disclose a conditional access system in which receivers receive and store authorization information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A Davis whose telephone number is (703) 305-8902. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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zad


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